

Case RN97085

Serial number: 09/463,525

AMENDMENT AFTER FINAL AND NOTICE OF APPEAL

REMARKS/ARGUMENTS

It is asserted that these amendments do not add new matter and are supported by the specification and claims as originally filed. Entry of these amendments is respectfully requested.

The amendment to the specification on page 6, lines 18-19:

- imides ( $[-CO-]_2N-H$ ), especially cyclic ~~amides~~ ones such  
as succinimide,

is based on the French counterpart on page 3, line 31 of the French published PCT whose number is WO 99/06462 (herewith enclosed) which reads as follows:

“ les imides ( $[-CO-]_2N-H$ ), surtout cycliques comme le succinimide,”

It clearly appears that the word “amides” has been erroneously added by the translator and should be canceled, the rest of the translation being fine. However, the phrase “ones” has been added in order to obtain an amendment grammatically correct.

Claims 27, 29, 30, 32, 37-40, 43, 45-50, and 53-55 have been rejected.

Claim 27 has been amended.

Claims 32, 37-40, 43, 46-49, and 53-55 are kept unchanged.

Claims 29, 30, 31, 45 and 50 are cancelled.

Claims 56-59 have been filed.

Claims 27, 32, 37-40, 43, 46-49, 53-55 and 56-59 are pending in the application.

The objection to the specification as failing to provide proper basis for the subject matter within line 10 of claim 27, is respectfully traversed and is addressed in light of the comments below. Amended claim 27 relates to an isocyanate composition masked

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with at least two masking agents, at least one of which contains a carboxylic function or the salt thereof, said masking agents being a product containing an >N-OH linkage, a phenol, an imide, or an unsaturated nitrogenous heterocycle, wherein the ratio in equivalents between the carboxylic acid functions or their salts thereof, on the one hand, and the isocyanate functions, on the other hand, is at least equal to 5%, and is not more than 2/3, said composition having a glass transition temperature at least equal to 20°C.

The first part of amended claim 27 related to "an isocyanate composition masked with at least two masking agents, at least one of which contains a carboxylic function or the salt thereof" finds support from page 7, line 22 to page 8, line 7.

The middle part of amended claim 27 related to "said masking agents being a product containing an >N-OH linkage, a phenol, an imide, or an unsaturated nitrogenous heterocycle" and new claims 56-59 find support from page 5, line 17 to the last line of page 6.

The last part of amended claim 27 related to "wherein the ratio in equivalents between the carboxylic acid functions or their salts thereof, on the one hand, and the isocyanate functions, on the other hand, is at least equal to 5%, and is not more than 2/3, said composition having a glass transition temperature at least equal to 20°C." finds support from page 8, line 15 to page 9, line 9.

For these reasons, Applicant respectfully requests that the Examiner now reconsider and withdraw the objection to the specification as failing to provide proper basis for the subject matter within line 10 of claim 27.

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Claims 27, 29, 30, 32, 37-40, 43, 45-50, and 53-55 have been rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art, that the inventor(s) at the time the application was filed, had possession of the claimed invention, is respectfully traversed and is addressed in light of the comments below.

As above explained, amended claim 27 finds support in the specification and claims as filed.

Claim 32 finds support on page 9, line 4 of the instant specification.

Claim 33 finds support on page 10, lines 1 and 2 of the instant specification.

Claims 37 and 38 find support on page 9, line 14-19 of the instant specification.

Claims 39 and 40 find support in combined claims 11 and 12 initially filed.

Claim 43 finds support in combined claims 14 and 13 initially filed.

Claim 45 finds support from page 5, line 17 to the last line of page 6 of the instant specification.

Claim 46 finds support in combined claims 17 and 1 initially filed.

Claim 47 finds support in combined claims 18 and 1 initially filed.

Claim 48 finds support in combined claims 19 and 1 initially filed.

Claim 49 finds support in combined claims 20 and 1 initially filed.

Claims 53 and 54 find support in combined claims 24 and 1 initially filed.

Claim 55 finds support in combined claims 25 and 1 initially filed.

New claims 56-59 find support from page 5, line 17 to the last line of page 6 of the instant specification.

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For these reasons, Applicant respectfully requests that the Examiner now reconsider and withdraw the rejection of claims 27, 29, 30, 32, 37-40, 43, 45-50, and 53-55, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art, that the inventor(s) at the time the application was filed, had possession of the claimed invention.

The rejection of claims 27, 29, 30, 32, 37-40, 43, 45-50, and 53-55 under 35 U.S.C. 102 (b) as being anticipated by EP 56167, is respectfully traversed and is addressed in light of the comments below.

EP 56167 relates to a combination of (A) polyurethane prepolymers containing carboxyl groups and derived from polyisocyanate, hydroxycarboxylic acids and blocking agents containing 1-40% of blocked isocyanate groups, and (B) homo- or hetero functional groups containing or generating hydroxyl groups (such as epoxide) in order to obtain a cross-linked product with a low COOH-groups contain.

First of all, Applicant submits that the teaching of that patent is not enabling because its content is vague, broad and confusing more particularly on the different kinds of masking agents which may be used. In that connection it should be noticed that no U.S. counterpart has been granted and that fact provides at least a clue supporting the above assertion.

EP 56167 does not teach an isocyanate composition masked with at least two masking agents, at least one of which contains a carboxylic function or the salt thereof, said masking agents being a product containing an >N-OH linkage, a phenol, an imide, or

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an unsaturated nitrogenous heterocycle. Moreover, EP 56167 does not teach a ratio in equivalents between the carboxylic acid functions or their salts thereof, on the one hand, and the isocyanate functions which are masked, free and which have reacted with the agent bearing carboxylic acid functions, on the other hand, being at least equal to 5%, and not more than one third. EP 56167 does not suggest that the instant isocyanate composition presents the unexpected property of increasing the glass transition temperature  $T_g$ . According to examples 7-9 and 16-19 of the instant specification,  $T_g$  increases from below 0°C to a value from 20 to 40 °C

In view of the above comments, the rejection of claims 27-55 under 35 U.S.C. 102 (b) as being anticipated by EP 56167, should be withdrawn.

For these reasons, Applicant respectfully requests that the Examiner now reconsider and withdraw the rejection of claims 27, 29, 30, 32, 37-40, 43, 45-50, and 53-55 under 35 U.S.C. 102 (b) as being anticipated by EP 56167.

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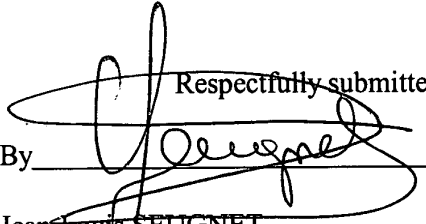
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In view of the preceding remarks, it is asserted that the patent application is in condition for allowance. Should the Examiner have any question concerning these remarks that would further advance prosecution of the claims to allowance, the examiner is cordially invited to telephone the undersigned attorney at (609) 860-4180. A notice of allowance is respectfully solicited.

August 12, 2003

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RN97085finalamend

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